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FACSIMILE COVER LETTER

To:	Examiner Joseph T. Woitach
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Date:	July 26, 2004
Re:	USSN 10/082,122 FLH Ref. No.: 674523-2024
Number of Pages: (including cover page)	4
cc:	

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PATENT
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants	:	Radcliffe *et al.*
U.S. Serial No.	:	10/082,122
Filing Date	:	February 26, 2002
For	:	TRANSGENIC ORGANISM
Examiner	:	Joseph T. Woitach
Art Unit	:	1632

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Thomas J. Kowalski

Signature

July 26, 2004

Date of Signature

RESPONSE TO OFFICE ACTION WITH REQUEST FOR WITHDRAWAL OF RESTRICTION REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This is in response to the Office Action dated June 25, 2004, for which a response is due by July 26, 2004, as July 25 was a Sunday. No fee is believed to be due; however, the Commissioner is authorized to charge any fee occasioned by this paper, or any other fees due in this application, to deposit account 50-0320.

The Office Action required election under 35 U.S.C. §121 from among the following groups:

I. Claims 2, 4-22, drawn to a method of producing a transgenic cell in vitro, classified in class 435, subclass 455;

II. Claims 2, 4-22, drawn to a method of producing a transgenic cell in vivo, classified in class 514, subclass 44;

III. Claim 23, drawn to a transgenic cell, classified in class 435, subclass 325; and

IV. Claims 24 and 25, drawn to a transgenic organism, classified in class 800, subclass 8.

Applicants elect group II, claims 2 and 4-22, with traverse for further prosecution in this application. It is noted that claims 1 and 3 link inventions I and II, and that, upon allowance of claim 1 or 3, the restriction between groups I and II will be withdrawn.

As a traverse, it is noted that the MPEP lists two criteria for a proper restriction requirement. First, the inventions must be independent or distinct. (MPEP § 803) Second, searching the additional inventions must constitute an undue burden on the Examiner if restriction is not required. *Id.* In this instance, neither criterion has been met, as the inventions are not independent or distinct, nor would there be an undue burden in searching and examining the pending claims in one application.

The claimed methods do not make materially different products, nor can the claimed products (cells and organisms) be made by different methods known in the art. While the claimed methods make either the claimed transgenic cell or transgenic organism, or both, the claimed products are dependent upon the claimed method of claim 1.

At the very least, group III, claim 23, should be included in the examined claims, as there would be no undue burden on the Examiner to search and consider claim 23, drawn to a transgenic cell. Indeed, in order to search the claimed methods of producing a transgenic cell, the transgenic cell must be searched and considered as well.

Enforcing the present restriction requirement would result in inefficiencies and unnecessary expenditures by both the Applicants and the PTO, as well as extreme prejudice to Applicants (particularly in view of GATT, a shortened patent term may result in any divisional applications filed). Restriction has not been shown to be proper, especially since the requisite showing of serious burden has not been made in the Office Action and there are relationships between the claimed combinations. Indeed, the search and examination of at least groups I, II and III is likely to be co-extensive and, in any event, would involve such interrelated art that the search and examination of groups I and II can be made without undue burden on the Examiner. All of the preceding, therefore, mitigate against restriction.

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In view of the above, reconsideration and withdrawal of the Requirement for Restriction are requested, and an early action on the merits earnestly solicited.

Respectfully submitted,

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